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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,411

02/12/2004

Charles Gordon

5943-00300

4318

7590

07/17/2009

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EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

07/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/777,411

**Applicant(s)**

GORDON ET AL.

**Examiner**

ANN SCHILLINGER

**Art Unit**

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 7/8/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-17, 19-23, 25-29, 32-34, and 39-43 are rejected under 35 U.S.C. 102(b) as being anticipated Vaccaro (US Pat. No. 6,102,950). Vaccaro discloses the following of the claimed invention: an intervertebral implant for a human spine, comprising: a cage element (20) with openings on its superior and inferior surfaces (please see Figure 2), and a side opening (70); first and second inserts with substantially planar support surfaces (upper and lower elements 50); an expansion member (40); and a raised portion (52). Please also see col. 6, lines 27-41, and col. 7, lines 15-64.

Vaccaro also discloses a first member (upper elements 50) comprising a first inferior surface and a first superior surface, where the first superior surface comprises a substantially planar surface configured to contact and support a first vertebrae of a human spine (Figs. 1-2); a second member (lower elements 50) comprising a second inferior surface and a second superior surface, where the second inferior surface comprises a substantially planar surface configured to contact and support a second vertebrae of a human spine; and an expansion element (40), wherein insertion of the expansion member will expand the first and the second members relative to one another. The implant further comprises a cage (20) with two sets of openings on the top

and the bottom of element 20, through which the first and the second members can expand (Fig. 2); and a third opening through which the expansion element is configured to be inserted (70)

Please note that claim language such as “adapted to/for” and “configured to/for” is functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 24, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaccaro in view of Sertich (U.S. Pat. No. 5,800,550). Vaccaro teaches the invention substantially as claimed, however, Vaccaro does not teach an osteoconductive mesh structure on the insert's support surface. Sertich teaches an intervertebral implant with an osteoconductive mesh structure in col. 4, lines 17-21 for the purpose of promoting bone ingrowth and fusion. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Vaccaro to include an osteoconductive mesh in order to promote bone ingrowth and fusion.

Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaccaro. Vaccaro discloses the claimed invention except for the support surface covering a majority of the

implant. It would have been an obvious matter of design choice to make the support surface cover a majority of the implant, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

***Response to Arguments***

In view of the amendments submitted on 4/21/2009, the 35 U.S.C. 112 rejections are withdrawn.

Applicant's arguments filed 4/21/2009 have been fully considered but they are not persuasive. The Applicant contends that Vaccaro does not disclose a support surface configured to support a vertebra. The examiner respectfully disagrees. Vaccaro discloses support surfaces in elements 50. As stated above, and in the previous rejection, there is insufficient structure in the claimed "support surface" to warrant the presence of the functional language. In order to be given patentable weight, there must be additional structural limitations added to the claimed feature of the "surface," or the functional recitation must be expressed as a "means" for performing the specified function (as set forth in 35 USC 112, 6<sup>th</sup> paragraph). The means for performing the specified function must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

The Applicant further contends that increasing the area of element 50 would render the insert unsatisfactory for its intended purpose. The examiner respectfully disagrees. Without evidence to the contrary, it is believed that the widening of element 50 would not hinder the

ability of element 52 to penetrate into the spinal vertebrae. Therefore, the change in size of element 50 would not destroy the functionality of the prior art.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./  
Examiner, Art Unit 3774

/DAVID ISABELLA/  
Supervisory Patent Examiner, Art Unit 3774